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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/312,404 05/14/99 BIRD

J MARSP0114US

QM12/0807

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EXAMINER

TUGBANG, D

ART UNIT	PAPER NUMBER
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3729

DATE MAILED:

08/07/01

Plase find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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**Advisory Action**

Application No.

09/312,404

Examiner

Dexter Tugbang

Applicant(s)

BIRD ET AL.

Art Unit

3729

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 July 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check only a) or b)]

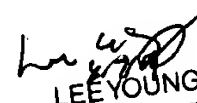
- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (see NOTE below);
  - (b) ☐ they raise the issue of new matter. (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

4. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Attachment.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 1-6 and 12-16.
- Claim(s) withdrawn from consideration: 7-11, 17-20.
9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
11. ☐ Other: \_\_\_\_\_

  
LEE YOUNG  
SUPERVISORY PATENT EXAMINER  
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Part of Paper No. 19

Art Unit: 3729

Attachment to Advisory Action

In response to the merits of McGaffigan, the Applicants argue the McGaffigan does not teach the following: 1) disposing a conductor around a *curved* former; 2) that the wire conductor 96 of McGaffigan is not a “hard-wire” electrical conductor because it is not a rigid conductor, such as a metallic bar or large diameter metallic wire; and 3) manufacturing a coil magnet.

The Examiner most respectfully disagrees. First, the claims are very broad as to when the step of “disposing...curved former” (lines 3-4 of Claim 1) occurs because there is no order recited in the steps as to when or what relationship each step occurs relative to each other. Second, the claims do not recite how the step of disposing occurs. As such, because the conductors 96 are clearly on, or “disposed” on, the former (rubber sheet 94) at two instances when the former 94 is **flat** (shown in Fig. 11) and also when the former 94 is **curved** (shown in Figs. 13 and 14), McGaffigan satisfies the limitation of “disposing... curved former” (lines 3-4 of Claim 1).

Regarding the limitations of the conductor being a “hard-wire” conductor, the claims do not recite to what degree of rigidity the conductor must be to be called a “hard-wire” conductor. The features of a hard-wire conductor being a metallic bar or large diameter metallic wire are not recited anywhere in the rejected claims and it appears that the Applicants are arguing more specifically than that which is claimed. Limitations from the specification are not read into the claims. *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, the wire conductors 96 of McGaffigan can be said to be “hard-wire” conductors.

With respect to the claims drawn to a coil for a magnet, these limitations recited in the preamble of the claims as intended use limitations and have not been given patentable weight

Art Unit: 3729

since the body of the claims do not depend upon the preamble for completeness and the process steps are able to stand alone. *In re Hirao*, 535 F.2d 67 190 USPQ 15 (CCPA 1976).

Regarding the merits of Kiekhafer et al, Kiekhafer was relied upon for the teachings of molding a rubber material in which McGaffigan uses an equivalent material of rubber. Each shares the concept of former rubber material in a curved shape over conductors. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).